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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,503	01/25/2002	David C. Issler	10294-607001	4327

7590

03/01/2004

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

12

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/057,503

Applicant(s)

ISSLER

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-22, 24, 25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-22, 24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 29, 2004 has been entered.

***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 5, 2003 have been accepted. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, 7, 18-20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haag 1,724,349 in view of Masseron 6,691,432. Haag '349 discloses substantially all the limitations of the claims including the following: an outsole 1 and 3 having an inner surface (top surface of 1) including an opening (that located above opening 6 in heel lifts); a footbed 7 positioned over the inner surface of the outsole; the footbed 7 having a lower surface including a plug 9 configured to be inserted into the opening (see Figures 1 and 4); the footbed formed of a material having a first hardness characteristic (made of rubber) that is less than an outsole material (for instance TPU or even wood) having a second hardness characteristic; the plug 9 is formed of a material having a first hardness characteristic that is less than an outsole material (for instance TPU or even wood) having a second characteristic; the footbed and the plug are formed of a material (both made of rubber) having substantially the same hardness; the opening is positioned in a heel area of the inner surface of the outsole (see Figures 1 and 4); an upper 2; an

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insole 7. Masseron '432 teaches that a sole can have a heel region that has an inner surface and an outer surface adapted to be in contact with a walking surface with an opening extending from the inner surface to the outer surface (see Figures 2, 3a, 9a-9c) and a plug 23 located within the opening and made of different materials to aid in preventing bottoming of the sole. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the opening of Haag '349 extend through the sole to the walking surface to aid in preventing bottoming out of the sole during impact. With respect to claims 18-20 and 23, the limitations of these method steps are met by the presence of the limitations in the product shown.

5. Claims 1, 7, 18 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaff 1,717,122 in view of Masseron 6,691,432. Schaff '122 discloses substantially all the limitations of the claims including the following: an outsole B (including top layer of the heel as seen in Figure 1), having an inner surface (that facing the inner portion of the shoe upper) including an opening (that located near D) and having a heel area (see heel in Figure 1) and a toe area (see Figure 1); a footbed H positioned over the inner surface of the outsole and extending from the heel to the toe (see Figure 4, heel is shown

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with plug, then the arch area is clearly shown by I, and then that portion forward of I is the toe end); the footbed having a lower surface including a plug E configured to be inserted into the opening (see Figure 1); the opening is positioned in a heel region of the inner surface (see Figure 1); an upper (see Figure 1); an insole H. Masseron '432 teaches that a sole can have a heel region that has an inner surface and an outer surface adapted to be in contact with a walking surface with an opening extending from the inner surface to the outer surface (see Figures 2, 3a, 9a-9c) and a plug 23 located within the opening and made of different materials to aid in preventing bottoming of the sole. Therefore, it would have been obvious to make the opening of Haag '349 extend through the sole to the walking surface to aid in preventing bottoming out of the sole during impact. With respect to claims 18 and 23, the limitations of these method steps are met by the presence of the limitations in the product shown.

6. Claims 5, 6, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haag 1,724,349 and Masseron '432 as applied to claims 1 and 18 in view of Design Choice. Haag '349 in view of Masseron '432 discloses all the limitations substantially as claimed except for the specific hardnesses of

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the material used for the outsole, footbed and plug. It appears that it would have been a mere matter of design choice to choose the hardness of the material to be used for the footbed, plug and outsole to meet the desired function of cushioning the user's foot upon impact and durability of the sole. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the footbed, plug and outsole out of a material made of any desired hardness to aid in cushioning the user's foot and prevent wear, as desired.

7. Claims 2-6 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaff 1,717,122 in view of Masseron '432 as applied to claims 1 and 18. Schaff '122 in view of Masseron '432 discloses all the limitations substantially as claimed. Schaff '122 in view of Masseron '432 does not specifically teach the material used for the footbed, plug and outsole. However, Schaff '122 does teach that the footbed and plug are cushions and that the sole is made to survive normal wear and tear. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cushion and plug out of a material that is less hard than the sole, to provide cushioning, while making the outsole out of harder material to survive normal wear and tear of the sole contacting the ground. With respect to the Shore hardness

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limitation, it appears that it would have been a mere matter of design choice to determine the hardness of the material to perform the desired function.

8. Claims 8-14, 16-17 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the references as applied to claims 1 and 8 above in view of Lober 844,882. The references as applied to claims 1 and 8 above disclose all the limitations of the claims except for the plug having a cap section and a pedestal with a lip being formed by the cap. Lober '882 teaches that a plug depending from the bottom surface of a footbed and fitted within the opening of a sole can have a pedestal b and cap b' with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap preventing accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of the references as applied to claims 1 and 8 above, with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening. With respect to the perimeters of the cap and pedestal, Lober '882 meets these limitations in as much as that which is shown and disclosed by the applicant.

9. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schaff 1,717,122 in view of Masseron '432 as



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applied to claim 28 above in view of Lober 844,882. Schaff '122 in view of Masseron '432 discloses all the limitations of the claim except for the plug having first and second protrusions with different peripheries with the second protrusion being attached to the first protrusion and having a periphery larger than the periphery of the first protrusion. Lober '882 teaches that a plug can depend from the bottom surface of a footbed and be fitted within the opening of a sole; the plug can have a pedestal (first protrusion b) and cap (second protrusion b') with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap prevents accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of Schaff '122 in view of Masseron '432 as applied to claim 28 above, with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening.

#### ***Response to Arguments***

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Haag teaches away from having an opening in extend from the inner surface to the outer surface adapted to be in contact with the walking surface because Haag

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teaches the opening to provide a bottom to compress air. This argument is not clearly understood. Haag teaches that the pneumatic chamber can be eliminated (see col. 2, lines 15-20) and therefore not necessary and allowing for the modification noted above. Applicant further argues that Schaff teaches away from applicant's invention because the footbed only extends to the arch area. This argument is not clearly understood since the claimed invention only requires an outsole assembly with a heel region and does not require it to extend over the entire area of the inner surface but only over an "area of said inner surface of said heel region". Therefore, Schaff reads on the claimed invention as applied above.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such

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papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

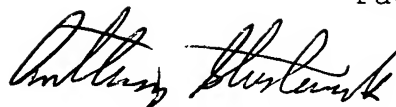
If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>

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Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS

February 19, 2004